

Application No. 10/806,311

REMARKS

Claims 1-14 and 21-29 are pending. Claim 20 is cancelled without prejudice in view of the restriction requirement. Claims 21, 23 and 27 have been amended to depend from claim 14 in view of the cancellation of claim 20. No new matter is introduced by the amendments.

All of the pending claims stand rejected. Applicant respectfully requests reconsideration of the rejections based on the following remarks.

Rejection Under Section 112

The Examiner rejected claims 9 and 10 under 35 U.S.C. § 112, first paragraph for failure to comply with the written description requirement. Specifically, the Examiner asserted that the specification did not provide support for the expression "the fibers are grafted with a second polymer." Applicant respectfully notes that this is supported by the specification at previously noted text. Applicants respectfully request reconsideration of the rejection based on the following comments.

As noted in the Preliminary Remarks, this language is supported in the specification at page 24, line 11 to page 25, line 24. This text corresponds with paragraphs [0095] to [0097] of the published application. Please see also paragraph [0101] which explicitly describes the grafting of acrylamide polymers onto PET fibers. According to the MPEP, the Examiner has the burden of establishing a *prima facie* case of lack of written description. Since the Preliminary Remarks pointed to support, the Examiner has clearly failed to meet his burden by not providing any specifics on his assertions. The specification clearly supports the claims, and the Examiner should withdraw this rejection or provide a *prima facie* showing of a lack of written description.

Application No. 10/806,311

Rejections Under Section 102

The Examiner rejected claims 1, 5-8, 12-14 and 28-29 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,693,067 to Purdy. With all due respect, the Examiner has failed to take into account all of the features of the claimed invention. Thus, the Purdy patent clearly does not *prima facie* anticipate Applicant's claimed invention. Applicant respectfully request reconsideration of the rejection based on the following comments.

"For a prior art reference to anticipate in terms of 35 U.S.C. § 102, **every element of the claimed invention must be identically shown in a single reference.** These elements must be arranged as in the claim under review, but this is not an 'ipsissimis verbis' test." In re Bond, 15 USPQ2d 1566, 1567 (Fed. Cir, 1990)(Internal citations omitted and emphasis added.). "Every element of the claimed invention must be literally present, arranged as in the claim. **The identical invention must be shown in as complete detail as is contained in the patent claim.**" Richardson v. U.S. Suzuki Motor Corp., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)(Internal citations omitted, and emphasis added.); see also MPEP 2131 (emphasis in original) ("**TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM**").

Claim 1 specifies that the fibers have "surface capillaries." The formation of surface capillaries is described in Applicant's specification through a reference to a patent to Thompson et al. in paragraph [0096]. The Examiner asserted that Purdy teaches "fibers 108 which has surface capillaries." However, reference number 108 refers to an expansion member, and no further information seems to be given on this element. Applicant could not identify any reference to surface capillary fibers in Purdy. Since Purdy does not teach all of the elements of Applicant's claimed invention, Purdy clearly does not render Applicant's claimed invention *prima facie* anticipated. Applicant respectfully requests withdrawal of the rejection of claims 1,

Application No. 10/806,311

5-8, 12-14 and 28-29 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,693,067 to Purdy.

Rejection Under Section 103

The Examiner rejected claims 2-4 and 11 under 35 U.S. C. § 103(a) as being unpatentable over Purdy. With all due respect, Purdy falls short in establishing *prima facie* obviousness of any of Applicant's claims. Applicant respectfully requests reconsideration of the rejection based on the following comments.

To render a claim obvious, the cited references or the knowledge of a person of ordinary skill in the art must teach or suggest all of the claim elements. This is not changed by the Supreme Court's KSR opinion.

As noted above, Purdy does not teach or suggest fibers with surface capillaries. The Examiner has completely ignored this issue other than asserting incorrectly that this feature is disclosed by Purdy. Surface capillaries provide improved flow through Applicant's filters relative to other fibers while providing desired collection of particulates. This improved performance has been demonstrated through superior performance in human clinical trials of Applicant's device. The claimed invention is simply not *prima facie* obvious over Purdy. Applicant respectfully requests withdrawal of the rejection of claims 2-4 and 11 under 35 U.S. C. § 103(a) as being unpatentable over Purdy.

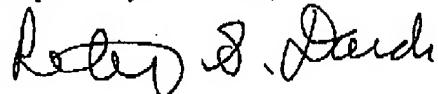
CONCLUSIONS

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

Application No. 10/806,311

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter S. Dardi". The signature is fluid and cursive, with the first name "Peter" and last name "Dardi" clearly distinguishable.

Peter S. Dardi, Ph.D.
Registration No. 39,650

Customer No. 62274
Dardi & Associates, PLLC
US Bank Plaza, Suite 2000
220 South 6th Street
Minneapolis, Minnesota 55402
Telephone: (404) 949-5730